



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/784,545

02/23/2004

Kevin George

50T5443.01

7768

42717 7590 02/14/2008

HAYNES AND BOONE, LLP  
901 Main Street  
Suite 3100  
Dallas, TX 75202

EXAMINER

NGUYEN, THUY-VI THI

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

02/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,545	<b>Applicant(s)</b> GEORGE ET AL.	
	<b>Examiner</b> THUY-VI NGUYEN	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/20/04</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 08/20/04 is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Parulski (US Patent No. 6,915,273).

Regarding to **claim 1**, Parulski discloses a method for processing at least one digital image to provide a photofinishing product to a user, comprising:

receiving at least one digital image located on a physical medium provided by the user [...user uploads digital images from removable memory card (330) to the fulfillment center (40) through network channel (36); col. 11, lines 62-67; col. 12, lines 1-5; figures 1A-B, 6 and 7, step (117)];

responsive to a user request, offering to the user at least one operator-definable package of photofinishing products [...a menu of photo products for customization such as printed sizes, matte style, frame are available to customer to select; col. 6, lines 31-45; and figure 2, steps (106 and 110) and figures 3-4];

receiving an input specifying at least one package selected by the user; and providing a photofinishing product to the user in accordance with the specified package [...user selects a menu of customizable features such as printed sizes; col. 6, lines 39-45 and figure 2, steps (108, 112); and photo product is delivered to the customer; col. 9, lines 6-11; figure 2, steps (118-124)].

Regarding to **claim 2**, Parulski discloses the package of photofinishing products includes a photographic print of the digital image provided in predetermined quantities and at least one predetermined size [figures 3-4].

Regarding to **claim 3**, Parulski discloses the package of photofinishing products includes a photographic print of the digital image provided in predetermined quantities for each of a plurality of predetermined sizes [figures 3-4].

Regarding to **claim 4**, Parulski discloses the package of photofinishing products further includes a price for said package [figure 2, step (106)].

Regarding to **claim 5**, Parulski discloses the package of photofinishing products further includes a second physical medium onto which the digital image is transferred [...a second physical medium such as DC-R, USB; col. 4, lines 61-63].

Regarding to **claim 6**, Parulski discloses wherein said photofinishing product is a second physical medium onto which the digital image is transferred [...a second physical medium such as DC-R, USB; col. 4, lines 61-63].

Regarding to **claim 7**, Parulski discloses said second physical medium is a CD-ROM [...input digital image from a CD-Rom disc; see col. 4, lines 61-63].

Regarding to **claim 8**, Paulski discloses receiving at least one digital image includes the step of receiving a plurality of digital images located on the physical medium [...user uploads digital images from removable memory card (330) to the network services provider; col. 11, lines 62-67; col. 12, lines 1-5; figures 6 and 7, step (117)]

and further comprising the step of receiving from the user a second input identifying at least one of the digital images to be embodied in the photofinishing product [...user can also select preferred colors, messages or images for the custom album cover; col. 8, lines 40-43].

Regarding to **claim 9**, Parulski discloses the step of displaying the digital images prior to the step of receiving the second input from the user [...after the digital images are uploaded, the user can also select preferred colors, messages or images for the custom album cover; col. 8, lines 25-28; col. 40-43 and figure 2, step (118)].

Regarding to **claim 10**, Parulski discloses the step of receiving an input from the user specifying at least one enhancement to the digital image [...customized graphics, text or image templates (col. 2, line 62); colors and logo; (col. 8, lines 40-43)].

Regarding to **claim 11**, Parulski discloses said enhancement is selected from the group consisting of brightness, contrast and retouching [...customized graphics, text or image templates (col. 2, line 62); colors; (col. 8, lines 40-43)].

Regarding to **claim 12**, Parulski discloses the step of receiving from the operator an input defining the predetermined quantities and the predetermined size of the package [...receiving the product information such as album the page size; col. 7, lines 57-66 and figure 5].

Regarding to **claim 13**, Parulski discloses said input is received at least in part via a touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding to **claim 14**, Parulski discloses said input is received at least in part via a keyboard [...keyboard 16; figure 1A].

Regarding to **claim 15**, Parulski discloses said input is received over a communications network [...network service provider 30; col.3, lines 56-59 and figure 1A-B].

Regarding to **claim 16**, Parulski discloses said inputs are received at least in part via a touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding to **claim 17**, Parulski discloses said inputs are received at least in part via a keyboard [...keyboard 16; figure 1A].

Regarding to **claim 18**, Parulski discloses inputs are received over a communications network [...network service provider 30; col.3, lines 56-59 and figure 1A-B].

Regarding to **claim 19**, Parulski discloses wherein the offering step is performed via a graphical user interface displayed on a monitor [...a menu of customizable features of photo product is displayed on monitor 14 or touchscreen display 84 for customer select; col. 6, lines 39-39-43 and figure 1A].

Regarding to **claim 20**, Parulski discloses the step of scanning at least one photographic image to produce said at least one digital image [...scanner 94; col. 4, lines 57-59 and figure 1A].

Regarding to **claim 21**, Parulski discloses a digital photofinishing system, comprising:

a digital image reader for receiving a physical medium on which at least one digital image is located [...card reader 96; col. lines 65-67 and figure 1A];

a digital image processor for producing an output image from the digital image located on the physical medium [...CPU mother board 82; col. 4, lines 45-49 and figure 1A];

an image output device for embodying the output image in an output medium [...color hardcopy printer 54; col. 5, lines 46-48 and figure 1B];

a monitor for displaying the output image and offering to a user at least one operator-definable package of photofinishing products [...touchscreen display 84; col. 4, lines 53-54 and figure 1A];

a controller operatively associated with the digital image reader, the digital image processor, the image output device and the monitor [...fulfillment center (40) communicates with home computer system (10) or retails kiosk 80 to perform the steps of selecting, configuring, purchasing and shipping a photo product (60); see col. 3, lines 56-61; col. 5, lines 7-10; and figures 1A-1B];

an operator interface operatively associated with the controller for selectively defining at least one package of photofinishing products to be offered to the user [...touchscreen display (84) in retails kiosk (80) or home computers system (10) for user to selecting the type of photo product to purchase; figures 1A-B].

Regarding to **claim 22**, Parulski discloses the package of photofinishing products includes a photographic print of the digital image provided in predetermined quantities and at least one predetermined size [figures 3-4].

Regarding to **claim 23**, Parulski discloses the package of photofinishing products includes a photographic print of the digital image provided in predetermined quantities for each of a plurality of predetermined sizes [figures 3-4].

Regarding to **claim 24**, Parulski discloses the package of photofinishing products further includes a price for said package [figure 2, step (106)].



Regarding to **claim 25**, Parulski discloses the package of photofinishing products further includes a second physical medium onto which the digital image is transferred [...input digital image from a CD-Rom disc; see col. 4, lines 61-63].

Regarding to **claim 26**, Parulski discloses said photofinishing product is a second physical medium onto which the digital image is transferred [...input digital image from a CD-Rom disc; see col. 4, lines 61-63].

Regarding to **claim 27**, Parulski discloses said second physical medium is a CD-ROM [...input digital image from a CD-Rom disc; see col. 4, lines 61-63].

Regarding to **claim 28**, Parulski discloses said image output device comprises a printer [...color hardcopy printer 54; col. 5, lines 46-48 and figure 1B].

Regarding to **claim 29**, Parulski discloses a user interface for receiving an input from the user specifying at least one enhancement to the digital image [...a menu of customizable features of photo product is displayed on monitor 14 or touchscreen display 84 for customer select; col. 6, lines 39-39-43 and figure 1A].

Regarding to **claim 30**, Parulski discloses said enhancement is selected from the group consisting of brightness, contrast and retouching [...customized graphics, text or image templates (col. 2, line 62); colors; (col. 8, lines 40-43)].

Regarding to **claim 31**, Parulski discloses said operator interface further serves as a user interface for receiving an input from the user specifying at least one enhancement to the digital image [...customized graphics, text or image templates (col. 2, line 62); colors and logo; (col. 8, lines 40-43)].

Regarding to **claim 32**, Parulski discloses said operator interface comprises a touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding to **claim 33**, Parulski discloses said operator interface comprises a keyboard [...keyboard 16; figure 1A].

Regarding to **claim 34**, Parulski discloses said user interface and said operator interface comprise a common touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding to **claim 35**, Parulski discloses said user interface and said operator interface comprise a common keyboard [...keyboard 16; figure 1A].

Regarding to **claim 36**, Parulski discloses a scanner for scanning a photographic image to produce a digital image to be processed by the digital image processor [...scanner 94; col. 4, lines 57-59 and figure 1A].

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
6. The US patents to Chauvin et al. disclose a software product for ordering of digital photo services over a communication network, and to Berarducci et al. disclose a method of selecting images from a plurality of images previously stored in a local digital memory to a services to be provided utilizing the images.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-

Art Unit: 3629

1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thuy-Vi Nguyen/

Examiner, Art Unit 3629

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629

Application/Control Number: 10/784,545  
Art Unit: 3629

Page 11